

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks. Claims 1, 18, 30, and 31 have been amended. 1-31 remain pending in the application after the instant amendments.

Claims 1-31 were rejected as being rendered obvious by either the combination of Riggan or Zinky in view of Sreenan and either Broerman (USPN 6594633) or Dan (USPN 6401111). Obviousness requires that the combination of references applied teach or suggest all the limitations in the claim. Applicants respectfully traverse the rejection of claim 1 under either ground because neither combination teaches or suggests an electronic service contract that includes "specifications including network performance goals modifiable by any one of the primary parties or the at least one sponsored party."

In the Office Action, the Examiner conceded that neither Riggan or Zinky disclose the use of a sponsored party. The Examiner also seems to concede that Sreenan does not disclose the use of a sponsored party. The issue is then whether Broerman or Dan cures the deficiencies of the combination of Riggan, Zinky, and Sreenan.

Applicants respectfully submit that Dan should be disqualified as a prior art reference under 35 USC 103(c) because the present application was filed after November 1999 and this application and Dan have a common owner. Section 804.03 of the MPEP provides, in relevant part:

"In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter that would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. . . For applications filed on or after November 29, 1999, the subject matter which was prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e) is also disqualified as prior art against the claimed invention if that subject matter and the claimed invention were commonly owned at the time the claimed invention was made. 35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103."

Both the present application and Dan are commonly owned by IBM Corp. The present application was filed on December 2001. Dan was filed on September 1998 but did not issue until June 2002. Because Dan was filed before the present application but issued after the filing of the application, Dan is considered a 102(e) reference. Therefore, Applicants respectfully submit that Dan should be disqualified as a prior art reference.

In light of the foregoing, the remaining question of patentability lies on whether Broerman cures the deficiencies of the aforementioned combination of references. Claim 1, as amended, requires that specifications in the contract include network performance goals "modifiable" by at least one sponsored party. The Examiner cites Fig. 3 in Broerman as showing third parties that may be considered sponsored parties.

Col. 7:5-67 through Col. 9:1-8 show a broker 22 that coordinates services for the buyer and seller (see Col. 7:25-27) and a transaction facilitator 24 that receives documentation from a real estate computer network to complete a transaction (see Col. 8:60-65). Because the facilitator is only shown to receive information and not to either input or modify contract information pertaining to the network performance goals, The facilitator in Broerman does not teach or suggest the contract construction step of claim 1.

The broker 22 performs (a service coordination function that includes (1) providing property information to a buyer (Col. 7: 31-34); (2) providing sales verification information to a seller (Col. 7:46-51); and monitoring a sales database (Col. 7:63-65). None of the functions associated with the broker relate to the modification of network performance goals in a service contract. Therefore, neither the facilitator 24 or the broker 22 in Broerman are shown to modify performance goals as required by claim 1. Consequently, the combination of Riggan or Zinky with Sreenan and Broerman fails to teach or suggest all of the limitations of claim 1. Therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn and the claim be allowed.

Applicants submit that the rest of the claims in the application recite either directly or by reference the "network performance goal" element of claim 1. Therefore, Applicants respectfully submit that the remaining claims should be allowed at least for the reasons set forth above related to the allowability of claim 1.

The Commissioner is hereby authorized to charge any fee(s) necessary to enter this paper and any previous paper, or credit any overpayment of fees to deposit account 09-0468.

Respectfully submitted,

By: 

Rafael A. Perez-Pineiro
Reg. No. 46,041
Phone No. (914) 945-2631

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598

10/017,814

Page 9 of 9